

## PTO Proposed Rules for Patent Term Adjustment

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This notice of proposed rulemaking is entitled "**Changes to Implement Patent Term Adjustment Under Twenty-Year Patent Term.**"

The comment deadline date is May 30, 2000 and there will be no public hearing.

The statutory changes which these rules are intended to implement are effective for patent applications, other than for designs, filed on or after May 29, 2000, so presumably these proposed rules will be in effect prior to the end of the May 30 public comment period?

The PTO has indicated that it prefers to receive comments via the Internet addressed to [patentterm.comments@uspto.gov](mailto:patentterm.comments@uspto.gov).

As a general comment, these proposed rules appear to provide the minimum patent term extensions required by the Statute, with one exception discussed below which appears to actually be contrary to the intent of the Statute.

The one specific proposed rule provision of this package which appears to be particularly worthy of public comment and objection is proposed **Section 1.703(f)**, which states that "the date indicted on any certificate of mailing or transmission under Section 1.8 shall not be taken into account in this calculation." The accompanying PTO Comment on this proposed Section 1.703(f) is on page 17218 of the Federal Register, in the middle of the middle column.

The effect of this proposed **Section 1.703(f)** rule would be to treat *legally timely* applicant responses as *UNtimely* "*non-diligent-prosecution*" under the subject new term extensions statute!

As effectively admitted in those PTO comments, this rule would de facto require the PTO to keep "two separate books", since the PTO cannot prevent a paper timely filed with a certificate of mailing

from being considered a timely paper. Yet the PTO is proposing in this rule proposal to only give Applicant credit for a timely response if the paper is actually RECEIVED by the Patent Office within the normal period for response (three months). In effect, the PTO in this proposed rule is attempting to "tack on" unknowable and unpredictable POST OFFICE delays onto Patent Office delays to deprive applicants of statutory "timeliness" for their timely papers! The PTO knows perfectly well that the vast majority of Applicant responses to PTO Office Actions are made within the last week of the [normal] three month response period, yet may not be stamped in as *received* by the PTO until after three months, unless hand-delivered to the PTO. Under this proposed Section 1.704(b), random delays by the Post Office could be used to deprive Applicants of term extensions to which they would otherwise be entitled by subtracting those Mail delay days from the applicant's statutory term extension.

There is no logical reason for this additional complexity, burden and paperwork requirement for both applicants and the PTO. The above-cited PTO comments virtually admit this by suggesting that applicants should use a [costly and time-consuming] "express mail" filing instead of a certificate of mailing for all of their papers! This not only violates the spirit and intent of the patent term extension act, it is clearly contrary to the intent of the Federal Paperwork Reduction Act, by imposing a burdensome and costly process on almost every paper filed in the prosecution of a patent application to avoid loss of statutory term extension entitlement, merely so that the PTO can begrudge Applicants of a few days of their term entitlement (or even longer in the case of a mail loss by the Post Office or the Patent Office).

This proposed rule is also obviously prejudicial and discriminatory to small or "non-Beltway" U.S. patent firms, corporations, and cost-sensitive small inventors, who must depend on [erratic] U.S. postal service to the PTO. In contrast, large local D.C. area firms would avoid the burden of this onerous proposed rule simply by their regular hand-filing (local delivery) to the PTO of all their papers.

P.S. As a general comment, is appreciated that this term extension legislation which must be implemented by the PTO is unduly complicated, and the PTO has this commentators full sympathy on that score. However, that is not the fault of the Patent Bar, nor is it a valid reason for PTO

implementing rules to make it even more complicated, as discussed above. This legislation was the result of difficult congressional negotiations to satisfy opponents of the original draft legislation who were trying to restore patent terms to 17 years from issuance, with the incentive to delay patent prosecution, and continue to obtain "submarine patents." The complexity of this legislation was intended by those opponents of the original draft legislation to ensure that there is no way that any patent applicant will be deprived of at least 17 years of patent term by any PTO delay whatsoever.

It has been informally reported, and hoped, that the PTO will be able to develop a computer program to automatically accurately calculate proper term extensions, thus and reduce the requirement for parties to file "applications for patent term adjustments" under proposed new Section 1.705. It is suggested that the PTO publish, or otherwise circulate, the proposed software algorithm for this term extension calculation for review by the Patent Bar in advance of implementing it. The previous long experience of most of the patent bar with PTO clerical and computer systems has not engendered complete confidence on the PTO's ability to successfully implement such a complicated new system without some outside assistance.

This purely personal comment is respectfully submitted by:

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